

REMARKS

Interview

Applicant would like to thank the Examiner for opportunity to telephonically interview the Examiner on November 23, 2004 concerning the instant application. During the interview, the Applicants presented the arguments set forth below concerning the rejections under 35 U.S.C. §103. A tentative agreement was reached that the foregoing amendments to claim 14 overcome the obviousness rejection based on Hord and Sato. The Examiner agreed to further consider whether the amendments to and arguments regarding claim 14 are sufficient to overcome the obviousness rejection based on Leeland and Plotkin et al.

Election of Group II

The Examiner indicated that claims 1-13 (Group I) were distinct from claim 14-20 (Group II), and restricted the present application to one of the Groups for examination purposes. Applicant affirms the election of Group II, claims 14-20. Claims 1-13 are withdrawn from consideration. Applicant hereby specifically reserves the right to prosecute claims 1-13 or claims of different scope in a divisional or continuation application.

Objection to the Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) on the basis that the embodiment of claim 18 should be illustrated in one or more figures. FIGS. 5-6 have been submitted to illustrate previously described embodiments of a cardholder as recited in claim 18. Written descriptive support for FIGS. 5-6 is found, for example, at page 6, line 28 to page 7, line 2 of the Applicant's specification as originally filed. No new matter has been added by these figures.

Formal drawings have been submitted to replace the original sheets including FIGS. 1-4. The formal drawings also include FIGS. 5-6. No new matter has been added.

Amendments to the Specification

New paragraphs have been added in the "DESCRIPTION OF DRAWINGS" section to provide a brief description of the views illustrated in FIGS. 5-6. No new matter has been added by this amendment.

Two sentences of the specification have been amended to refer to FIGS. 5 and 6. No new matter has been added by this amendment.

The Examiner objected to the use of the word "invention" in the abstract. The abstract has been amended to remove the word "invention" from line 2. No new matter has been added by this amendment.

Claim Objections

Claims 14-20 are objected to in view of certain informalities. Claim 14 has been amended to recite "the" rear side (rather than "its" rear side). Claim 18 has been amended to refer to "respective cavities" (rather than "the respective cavities"). Claim 20 has been amended to refer to "the message or greeting" defined in claim 14. No new matter has been added by these amendments. Applicant notes that these claim amendments are made solely for the purposes of correcting informalities, and not for purposes of overcoming prior art. It is not believed that these amendments narrow the scope of the claims.

Rejections under 35 U.S.C. § 112

Claims 14-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 has been amended to refer to include only one instance of the phrase "a frame," thereby providing an antecedent basis for subsequent instances of phrase "the frame." Also, claim 14 has been amended to positively recite "a second viewing window." Dependent claim 18 has been amended to refer to the "card" defined in claim 14 and to "a second card." No new matter has been added by these amendments.

Rejections under 35 U.S.C. § 103

Claims 14-17, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hord (U.S. Patent No. 4,856,213) in view of Sato et al. (U.S. Patent No. 5,518,274).

Applicant respectfully submits that Hord and Sato et al., in combination, do not teach or suggest every element recited in independent claim 14. As such, these references do not render obvious claim 14 or dependent claims 15-17, 19, and 20.

During the above-referenced interview the Applicant agreed to amend independent claim 14 to positively recite the second viewing window to overcome the instant rejection.

Claims 14-17 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791).

Applicant respectfully submits that Plotkin et al. and Leeland, in combination, do not render obvious amended independent claim 14 or its associated dependent claims.

First, neither Plotkin et al. nor Leeland disclose that a message or greeting is transcribed on a card and inserted into a cardholder. Unlike the cited references, claim 14 recites a method that includes transcribing on a card a message or greeting and removably inserting the card in the cardholder. Plotkin et al. teaches permanently securing an authenticity label 28 to the back side of a frame 30 and Leeland teaches simultaneously displaying a person's autograph (on a card 11) and that person's photograph on the front side of a picture frame 2. Nowhere do these references suggest or disclose that a message or greeting is transcribed on a card and inserted into a cardholder on the rear side of a frame. Thus, even if Leeland were properly combinable with Plotkin, the combination would not teach each and every element of claim 14.

Moreover, the Leeland reference may not be properly combined with the Plotkin et al. reference. The purpose of the Plotkin et al. device is to "permanently secure" an authenticity label 28 to the back of a framed pictorial work to authenticate the framed photo and prevent fraudulent duplications. (Col. 1, lines 18-31, 62-67; Col. 3, lines 56-60.) Adapting Leeland's paper folder 3 to removably display Plotkin's authenticity label 28 on the back side of Plotkin's frame 30 would defeat the entire purpose of Plotkin et al., namely, to permanently secure

authenticity information the back of a frame to reliably authenticate the framed artwork. Accordingly, one skilled in the art would not find any motivation to combine Leeland and Plotkin et al.

Furthermore, independent claim 14 positively recites that the cardholder has a second viewing window. Applicant submits that inclusion of a viewing window on a cardholder that is not in direct view under normal viewing conditions is counterintuitive and nowhere suggested by either reference. One skilled in the art, prior to reviewing Applicant's disclosure, would find no motivation to provide a cardholder with a viewing window on the rear side of a picture frame.

Applicant submits that Plotkin et al. and Leeland merely disclose well-known solutions to problems that are completely different from that solved by the claimed invention. Plotkin et al. provides a way to permanently affix authentication to a frame so that it is not conspicuous under normal viewing conditions. Leeland provides a way to simultaneously display a person's autograph and photograph. Neither reference addresses the problem of how to provide a framed photo with a means for conveniently and removably attaching a personalized greeting or message in a way that does not detract from the visual appearance of the framed item. The instant claims, Applicant submits, are directed to an entirely new product format that serves fundamentally different purposes than the previously known product formats of Plotkin et al. and Leeland.

Applicant respectfully submits that claims 14-20 describe patentable subject matter and are in condition for allowance.

Applicant : Mary E. Gentry
Serial No. : 10/617,851
Filed : July 11, 2003
Page : 13 of 13

Attorney's Docket No.: 13213-048001

No fee is believed due. Please apply any deficiencies or credits to deposit
account 06-1050.

Respectfully submitted,

Date: _____

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Greg H. Gardella
Reg. No. 46,045

Fish & Richardson P.C., P.A.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

Applicant : Mary E. Gentry
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Page : 8 of 13

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Amendments to the Drawings:

The attached formal drawings replace the original sheets including FIGS. 1-4.

The attached formal drawings also include new FIGS. 5-6. These new figures illustrate embodiments that were previously described in Applicant's written specification as originally filed. No new matter has been added.

Attachments following last page of this Amendment:

Formal Drawings (7 sheets)